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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,460	10/10/2001	Andrew Ernest Fano	10022/187	4729

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CHICAGO, IL 60610

EXAMINER
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DIXON, THOMAS A

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 05/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/975,460	FANO, ANDREW ERNEST
	Examiner	Art Unit
	Thomas A. Dixon	3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 03 March 2003.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.
- 4) Claim(s) 20-72 is/are pending in the application.
- 4a) Of the above claim(s) 1-19 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 20-72 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Disposition of Claims

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ .
- 4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.  
5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment and Arguments***

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Claim Objections***

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 54-73 been renumbered 53-72.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- Amend*
3. Claim 66 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 66 recites the limitation depends from itself.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

- Chnl 1112*
4. Claim 60 is rejected under the judicially created doctrine of double patenting over claim 1 of U. S. Patent No. 6,317,718 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

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The claims of the instant application are a separation of the features claimed in the previous application, now patent 6,317,718.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See also MPEP § 804.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 20-26, 28-34, 36, 38-40, 42-47, 49-54, 56, 58-59, 61-65, 67-68, 70-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bouve et al (5,682,525) in view of Ogasawara (6,123,259).

As per Claims 20, 28.

Bouve et al ('525) discloses:

obtaining information identifying an item of merchandise from a user, see page column 2, lines 26-31;

determining a physical location of a user, see column 2, lines 46-52;

querying a computerized network of information utilizing a query based on the information identifying the item of merchandise and the physical location of the user, see column 2, lines 26-28, column 3, line 45, column 11, lines 15-19 and lines 24-29;

receiving from a retailer-based agent in response to the query information associated with the item of merchandise from the retailer proximate to the user being associated with the item of merchandise that the user desires to purchase, see column 11, lines 8-14 figures 2 (32, 34) and 4 (73, user may print a list of information about these items or select one by clicking" in which "computer products" are the items of interest, see column 5, lines 4-13.

displaying the information and a physical location of the retailer, see column 11, lines 8-14.

Bouve et al ('525) does not disclose a customized offer.

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Ogasawara ('259) teaches a customized offer based on customer's location and previous shopping history, see column 6, lines 40-54, for the benefit of customer convenience.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to display the customized offer taught by Ogasawara (259) in the invention of Bouve et al ('525) for the benefit of customer convenience.

As per Claim 21, 29, 43, 50, 62, 65

Bouve et al ('525) further discloses a list, see column 2, lines 13-16.

As per Claim 22, 30, 44, 51.

Bouve et al ('525) further discloses a query based on the list and user's location, see column 2, lines 13-16 and column 11, lines 3-14.

As per claim 23, 31, 45, 52.

Bouve et al ('525) further discloses the list is generated by the user at a location remote from the retailer, see column 6, lines 39-67.

As per Claim 24, 32, 38, 46, 53, 58.

Bouve et al ('525) further discloses displaying a list of items, see figure 4 (73) and column 11, lines 8-14.

Bouve et al ('525) does not specifically disclose displaying the prices associated therewith.

Ogasawara ('259) teaches displaying prices associated with items, see figure 3, for the benefit of customer convenience.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to display the item prices as taught by Ogasawara (259) in the invention of Bouve et al ('525) for the benefit of customer convenience.

As per Claim 26, 47

Bouve et al ('525) further discloses the internet, see column 11, lines 24-30.

As per Claim 34, 54

Bouve et al ('525) further discloses pattern recognition to enhance the location of pertinent information, see column 8, lines 63-67.

As per Claim 36, 61, 63, 64, 67, 68.

Bouve et al ('525) discloses:

obtaining information identifying an item of merchandise from a user, see page column 2, lines 26-31;

determining a physical location of a user, see column 2, lines 46-52;

querying a computerized network of information utilizing a query based on the information identifying the item of merchandise and the physical location of the user, see column 2, lines 26-28, column 3, line 45, column 11, lines 15-19 and lines 24-29;

receiving information from an agent in response to the query information about an item, the item of merchandise being associated with the item the customized offer for sale of the item of merchandise from the retailer proximate to the user being associated with the item of merchandise that the user desires to purchase, see column 11, lines 8-14 figures 2 (32, 34) and 4 (73, user may print a list of information about these items or select one by clicking" in which "computer products" are the items of interest, see column 5, lines 4-13.

displaying the purchasing information.

Bouve et al ('525) does not disclose a customized offer.

Ogasawara ('259) teaches a customized offer based on customer's location and previous shopping history, see column 6, lines 40-54, for the benefit of customer convenience.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to display the customized offer taught by Ogasawara (259) in the invention of Bouve et al ('525) for the benefit of customer convenience.

As per Claim 25, 33, 39, 59.

Bouve et al ('525) does not disclose suggesting items for sale.

Ogasawara ('259) teaches a customized offer based on customer's location and previous shopping history, see column 6, lines 40-54, for the benefit of customer convenience.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to suggest items for sale as taught by Ogasawara (259) in the invention of Bouve et al ('525) for the benefit of customer convenience.

As per Claim 40.

Bouve et al ('525) does not disclose recognizing patterns to suggest items for sale.

Ogasawara ('259) teaches a customized offer based on customer's location and previous shopping history, see column 6, lines 40-54, for the benefit of customer convenience.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to display the customized offer as taught by Ogasawara (259) in the invention of Bouve et al ('525) for the benefit of customer convenience.

As per Claims 42, 48.

Bouve et al ('525) discloses:

obtaining information identifying an item of merchandise from a user, see page column 2, lines 26-31;

determining a physical location of a user, see column 2, lines 46-52;

querying a computerized network of information utilizing a query based on the information identifying the item of merchandise and the physical location of the user, see column 2, lines 26-28, column 3, line 45, column 11, lines 15-19 and lines 24-29;

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receiving from a retailer-based agent in response to the query information associated with the item of merchandise from the retailer proximate to the user being associated with the item of merchandise that the user desires to purchase, see column 11, lines 8-14 figures 2 (32, 34) and 4 (73, user may print a list of information about these items or select one by clicking" in which "computer products" are the items of interest, see column 5, lines 4-13.

displaying the information and a physical location of the retailer, see column 11, lines 8-14.

Bouve et al ('525) does not disclose a customized offer or suggesting items.

Ogasawara ('259) teaches a customized offer and suggesting items based on customer's location and previous shopping history, see column 6, lines 40-54, for the benefit of customer convenience.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to display the customized offer taught by Ogasawara (259) in the invention of Bouve et al ('525) for the benefit of customer convenience.

As per Claim 56.

Bouve et al ('525) discloses:

obtaining information identifying an item of merchandise from a user, see page column 2, lines 26-31;

determining a physical location of a user, see column 2, lines 46-52;

querying a computerized network of information utilizing a query based on the information identifying the item of merchandise and the physical location of the user, see column 2, lines 26-28, column 3, line 45, column 11, lines 15-19 and lines 24-29;

receiving information from an agent in response to the query information about an item, the item of merchandise being associated with the item the customized offer for sale of the item of merchandise from the retailer proximate to the user being associated with the item of merchandise that the user desires to purchase, see column 11, lines 8-14 figures 2 (32, 34) and 4 (73, user may print a list of information about these items or select one by clicking" in which "computer products" are the items of interest, see column 5, lines 4-13.

displaying the purchasing information.

Bouve et al ('525) does not disclose a customized offer or suggesting items for sale.

Ogasawara ('259) teaches a customized offer based on customer's location and previous shopping history, see column 6, lines 40-54, for the benefit of customer convenience.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to display the customized offer taught by Ogasawara (259) in the invention of Bouve et al ('525) for the benefit of customer convenience.

As per Claim 70.

Bouve et al ('525) discloses:

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a retailer agent configured to provide a computerized network of information related to items of merchandise from a plurality of retailers and to determine a physical location of a mobile shopper, see column 2, lines 10-52;

a shopping agent communicatively coupled with the retailer agent and configured to store information related to desired items of merchandise, see column 1, line 60 – column 2, line 9.

Bouve et al ('525) does not disclose an offer of items for sale.

Ogasawara ('259) teaches a customized offer based on customer's location and previous shopping history, see column 6, lines 40-54, for the benefit of customer convenience.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to display the customized offer taught by Ogasawara (259) in the invention of Bouve et al ('525) for the benefit of customer convenience.

As per Claim 71.

Bouve et al ('525) further disclose the display of the location of the retailer proximate the shopper with respect to the location of the shopper, see column 2, lines 46-52.

6. Claims 27, 35, 41, 48, 55, 60, 66, 69, 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bouve et al (5,682,525) in view of Ogasawara (6,123,259) further in view of Bianco (5,047,416).

As per Claim 27, 35, 41, 48, 55, 60, 66, 69, 72.

Bouve et al ('525) does not specifically disclose alerting the user to the best price.

Bianco ('416) teaches alerting the users to better values, see column 4, lines 1-8, for the benefit of increased customer service.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to alert the customers of Bouve et al ('525) of the best price or better values as taught by Bianco ('416) for the benefit of increased customer service.

7. Claims 37, 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bouve et al (5,682,525) in view of Ogasawara (6,123,259)

As per Claim 37, 57.

Bouve et al ('525) does not specifically disclose parsing the terms based on predefined criteria to create the query.

Official notice is taken that parsing is old and well known in the database arts. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to parse the input to create a query because this would save time for the recipient of the information.

***Allowable Subject Matter***

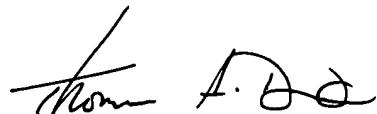
The limitations of Claims 25, 33, 39 have been incorporated into new claims 42, 49, 56. Updated search has revealed that the claims are not, in fact allowable.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (703) 305-4645. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



Thomas A. Dixon  
Examiner  
Art Unit 3629

May 13, 2003